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IN THE

Supreme Court of the United States

OCTOBER TERM, 1958

No. 220

CHARLES K. HARRIS MUSIC PUBLISHING CO., INC.,

Petitioner,

—against—

EDWARD B. MARKS MUSIC CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

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No.

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EDWARD B. MARKS MUSIC CORPORATION,

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

To the Honorable, the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Petitioner prays that a writ of certiorari issue to review so much of the judgment of the United States Court of Appeals for the Second Circuit in the within action, dated and entered May 16, 1958, as reverses the amended declaratory judgment of the United States District Court, Southern District of New York, entered on February 3, 1956, insofar as it denied plaintiff's motion for the apointment of a master to take evidence, compute, ascertain and report concerning infringements, damages, and profits, and remands this cause to the District Court for further proceedings in accordance with its opinion.

Opinions Below

The opinion of the District Court denying plaintiff's motion for the appointment of a master to assess money damages and profits (Appendix I, infra) is unreported. The opinion of the Court of Appeals reversing the amended declaratory judgment of the District Court insofar as it denied plaintiff's aforesaid motion (Appendix I, infra) is reported in 117 U. S. P. Q. 308.

Jurisdiction

The judgment of the Court of Appeals (Appendix II, infra) is dated and was entered on May 16, 1958. Jurisdiction is conferred on this Court by 28 U. S. C. Section 1254(1) which reads as follows:

> "28 U. S. C. Section 1254. Court of Appeals: CERTIORARI; etcetera.
>
> Cases in the courts of appeals may be reviewed by the Supreme Court by the following method:
>
> (1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after the rendition of judgment or decree."

Question Presented

Is a plaintiff who has delayed for eleven years in bringing an action for declaratory judgment to trial guilty of such laches as to estop it from claiming damages and profits in addition to the declaratory and injunctive relief awarded it?

Statutes and Rules Involved

The only statute involved is 28 U. S. C. Sec. 2202, which reads as follows:

> "Further necessary or proper relief based on a declaratory judgment or decree may be granted after reasonable notice and hearing against any adverse party whose rights have been determined by such judgment."

The only rule involved is F. R. Civ., Proc. rule 54(c), which reads as follows:

> "Except as to a party against whom a judgment is entered by default, every final judgment shall grant the relief to which the party in whose favor it is rendered is entitled even if the party has not demanded such relief in his pleadings."

Statement

Plaintiff and defendant, both music publishers, sought a declaratory judgment establishing their respective owership through Joseph E. Howard of his interest in the United States renewal copyrights in certain musical compositions composed by Howard as co-writer (148a).*

The District Court's amended judgment declared defendant to be the sole owner of Howard's interest in some of the renewal copyrights and plaintiff to be the sole owner of Howard's interest in the remainder

* All references to pages followed by "a", are references to appendices printed in the Court of Appeals and presented herewith. Pages 1a-81a are part of plaintiff's appendix. Pages 82a-135a are part of defendant's appendix. Pages 136a-159a are part of plaintiff's supplemental appendix.

of said renewal copyrights (76a); and awarded injunctive and incidental relief accordingly (77a-79a).

A motion by plaintiff (28a) pursuant to 28 U. S. C. Sec. 2202 for the appointment of a master to take evidence, compute, ascertain and report concerning infringements by defendant of plaintiff's renewal copyrights and to assess damages and profits in connection therewith, was denied by the District Court (73a, Appendix I, infra).

On plaintiff's appeal from this denial, the Court of Appeals reversed and remanded for further proceedings in accordance with its opinion (Appendix I and II, infra). On defendant's appeal, the Court of Appeals affirmed.

This action was instituted in 1944 and was tried in 1955, eleven years later (1a). More than seven years elapsed after the action was started before plaintiff took its first step towards prosecuting the same by serving on December 17, 1951, a notice to take defendant's deposition (84a). During the eleven years that the action was pending in the District Court, it was marked off the trial calendar twice and remained off the calendar for two years and 10 months (83a and 84a).

Plaintiff admittedly knew, as far back as October, 1937, that defendant's predecessor in interest, Cora L. Harris, made a claim to the renewal copyright of the composition "I WONDER WHO'S KISSING HER NOW", one of the compositions involved in this action. Plaintiff admittedly knew, as far back as March, 1938 that defendant's predecessor made a claim to the re-

newal copyrights in all the other compositions involved in this action (41a, 73a, 87a).

The only action which plaintiff took before the institution of this suit in 1944, was to start an action against Harris with respect to only the composition, "I Wonder Who's Kissing Her Now", one of the many involved in this suit, which it discontinued on the merits in 1945 (49a, 50a, 73a).

The complaint in this action contains no allegations of any infringing acts on the part of the defendant or anyone else. It alleges merely that a controversy exists with respect to which plaintiff needs a declaration because defendant represented that it owned Howard's interest in the renewal copyrights (3a, 5a, 6a). Though the complaint was amended 10 years after this action had been pending, plaintiff did not by these amendments allege any infringing acts. At no time did plaintiff demand a declaration of infringement or an accounting (73a, Appendix I, infra). Plaintiff at the trial, did not prove any acts of infringement, but proved only the controversy relating to ownership.

Basis for Federal Jurisdiction

Federal jurisdiction in the District Court was based on diversity of citizenship and amount, and on the existence of a question arising under the Copyright Act of 1909, Chap. 320, 35 Stat. 1075 now 17 U. S. C. (3a) and 28 U. S. C. Sec. 1338, which reads as follows:

> "28 U. S. C. Sec. 1338. Patents, Copyrights, Trade Marks and Unfair Competition.
>
> (a) The district courts shall have original jurisdiction of any civil action arising under

any Act of Congress relating to patents, copyrights and trade-marks. Such jurisdiction shall be exclusive of the courts of the states in patent and copyright cases."

Reasons for Granting the Writ

The Decision Sought to Be Reviewed Is in Conflict With Decisions of Other Courts of Appeals as Well as With a Prior Decision of the Same Court of Appeals and Is in Conflict With Applicable Decisions of This Court on the Same Federal Question.

This Court held in *Johnston* v. *Standard Mining Co.*, 148 U. S. 360 and *Willard* v. *Wood*, 164 U. S. 502, 525, that the mere institution of a suit does not relieve a plaintiff from laches, and if the plaintiff fails, as this plaintiff did, to prosecute his suit diligently, the consequences are the same as if no suit had been started.

That rule has since been followed and applied in *Bankers Trust Co.* v. *Virginia Railway & Power Co.*, 4 Cir., 273 Fed. 999. *Haynes & Co.* v. *Druggists' Circular*, 2 Cir., 32 F. 2d 215, 217; *Pollitzer* v. *Foster*, 6 Cir., 59 F. 2d 901, 903 and *The Kermit*, 9 Cir., 76 F. 2d 363, 367.

In *Pollitzer* v. *Foster*, supra, the Court refused to permit a plaintiff to recover in a patent infringement suit where the plaintiff delayed eleven years in bringing the suit to trial. The Court said at p. 903:

> "Again the failure diligently to prosecute a suit may be as fatal to a claimant's right to recover as if no action had been instituted (citing

cases). This principle is applicable to the plaintiffs' claims based on the Hartford patent. Suit was brought on that patent in 1913, but was abandoned, and more than five years later another suit was instituted which was not brought to trial until nearly eleven years thereafter. There is nothing in the record to show that this latter action might not have been prosecuted with expedition. Five years elapsed between the filing of the answer and the taking of any step looking to the prosecution of the case. Six more years elapsed before it was brought to trial. The record fails to show any reason for these delays * * *. In view of their inaction as to this patent, the plaintiffs cannot be permitted at this late date to recover thereunder."

In *Haynes & Co.* v. *Druggists' Circular*, supra, a plaintiff in a copyright infringement suit who had obtained an interlocutory decree of infringement was barred from recovering money damages because of its delay for nine years in proceeding before a Special master. The Court said at p. 217:

"Merely instituting a suit does not of itself relieve a person from the operation of the rule of laches; if he fails to prosecute his suit diligently, it is the same as though no suit had been begun. (citing cases) * * *. Lapse of time is an important element of laches, and where, as here, a case has been delayed in proceeding before a master to whom the cause has been referred, and delayed beyond the operation of the longest period of a statute of limitations for tort or contract, the bar of laches is a good defense to the entry of a final decree involving a money judgment.

> Here nine years elapsed between the first hearing before the master and a continuation of the hearings before him. Long lapse of time has been held sufficient of itself to prevent relief."

Although the Court below recognized the doctrine of the foregoing decisions, it committed error when it held that only "substantial delay which causes *actual prejudice* to the adverse party, can constitute laches" (Appendix I, infra, italics ours).

Prejudice will be presumed or implied from a long and unreasonable delay in the prosecution of an action. *Hicks* v. *Bekins Moving & Storage Co.*, 9 Cir., 115 F. 2d 406; *Haynes & Co.* v. *Druggists' Circular*, supra, p. 217; *Brown* v. *County of Buena Vista*, 95 U. S. 157, 161.

Prejudice will also be presumed or implied where the delay goes beyond the analogous statute of limitation. *Haynes & Co.* v. *Druggists' Circular*, 2 Cir., 32 F. 2d 215; *Reconstruction Finance Corp.* v. *Harrisons & Crosfield*, 2 Cir., 204 F. 2d 366, 367; *Morales* v. *Moore-McCormack Lines*, 5 Cir., 208 F. 2d 218; *McGrath* v. *Panama Railway Co.*, 5 Cir., 298 F. 303; *Redman* v. *United States*, 2 Cir., 176 F. 2d 713; *Shell* v. *Strong*, 10 Cir., 151 F. 2d 909; *Hammond* v. *Hopkins*, 143 U. S. 224, 273; *Westfal-Larson* v. *Allman-Hubble, etc.*, 9 Cir., 73 F. 2d 200.

Plaintiff's delay for 11 years in prosecuting this action was long, unreasonable and for a longer period than the analogous six year statute of limitation. *Greenbie* v. *Noble*, D. C. S. D. N. Y. 151 F. Supp. 45, 62.

The District Court properly found, in the exercise of its discretion, that such delay on the part of this plaintiff amounted "to such laches as to estop it from claiming damages and profits", and recognizing "The difficulty in assessing damages for acts committed so many years ago", properly found that the prejudice to the defendant therefrom was "manifest" (Appendix I, infra).

In reversing the District Courts' finding of "manifest prejudice", and requiring a showing of actual instead of implied or presumed prejudice, the Court of Appeals made a decision which is in direct conflict with the cited decisions of this Court and of the other Circuits and in conflict with its own decisions, especially its decision in *Haynes & Co.* v. *Druggists' Circular*, supra.

The defendant did not participate in plaintiff's delay in bringing this action to trial. It must be remembered that seven years elapsed between the filing of the answer and the taking of any step by plaintiff looking to the prosecution of the case.

This action had been pending almost eight years before defendant made its first request for a postponement (62a). During the eleven years that this action was pending, defendant requested five adjournments for a total period of four months and nineteen days (62a, 68a-71a). Two of these adjournments became necessary because of the sudden illness of a witness, Monroe, who was to attend the trial in person, and whose deposition was taken by defendant and offered and received in evidence at the trial of this action (70a, 71a, 97a).

It is obvious that all the other requests for adjournments were made by plaintiff, in spite of the fact that the affidavit of its attorney or his associate may state that defendant "joins in the request" (52a-59a, 63a-67a, 72a). For example, can it be said that defendant requested the adjournment where an affidavit is submitted by plaintiff's attorney or his associate, and the reason for the adjournment is that plaintiff's attorney is preparing for another trial (53a); or that plaintiff is securing "further data" for use upon the trial (57a, 58a); or that plaintiff's attorney was in England (66a)?

In *Hicks* v. *Bekins Moving & Storage Co.* supra, the Court said at p. 409:

> "The duty rests upon the plaintiff at every stage of the proceeding to use diligence and to expedite his case to a final determination * * *".

To the same effect: *Sweeny* v. *Anderson*, 10 Cir., 129 F. 2d 756, 758.

We respectfully submit that it requires no citation of authority to establish, and this Court must be judicially aware of, the fact that it is the plaintiff and not the defendant who controls the prosecution of a law suit, and it is the plaintiff and not the defendant who can say how soon the action shall be brought to trial.

Conclusion

The granting of a writ of certiorari is necessary to correct the conflict brought about by the decision in the Court below, which permits a plaintiff, who has unreasonably delayed bringing a suit for declaratory judgment to trial, to make, 11 years after the institution of the suit, an application for the appointment of a special master to assess damages and profits.

Dated, New York, July 15th, 1958.

Respectfully submitted,

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Attorney for Petitioner.

MAXWELL OKUN,
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Of Counsel.

APPENDIX I

Opinion of District Court Denying Plaintiff's Motion for Appointment of a Special Master to Assess Damages and Profits.

Plaintiff is entitled to similar affirmative relief with respect to compositions listed in Group 2 as was granted defendant with respect to those in Group 1. Accordingly the judgment will be amended as follows:

Paragraph 3 of the judgment which was entered is stricken and the following recital substituted:

"3. Plaintiff has at all times been, and now is, the sole owner and proprietor of the interest through Joseph E. Howard in the renewal copyright of each of the musical compositions listed in Group 2".

Paragraph 6 is amended to include injunctive relief with respect to the compositions in Group 2 as well as those in Group 3; paragraph 8 is amended to include a declaration of invalidity, etc. with respect to Group 2 as well as Group 3.

A provision for further relief based on this judgment under Section 2202, 28 USCA, and the appointment thereunder of a Master to assess damages and profits is not warranted in this suit. Plaintiff has not sought a declaration of infringement or an accounting. As early as March, 1938 it had knowledge that defendant's predecessor made claim to the litigated renewal copyrights, and particularly with respect to the one composition singled out by plaintiff (on this motion) as a source of revenue far above the average ("I Wonder Who's Kissing Her Now"), it had such knowledge as early as October 1937. Moreover, a suit started by plaintiff against defendant's predecessor involving this song was in 1943 discontinued on the merits;

not until 1944 did plaintiff file the instant action and for 11 years delayed prosecution of it. This unreasonable delay on the part of plaintiff in asserting its rights amounts to such laches as to estop it from claiming damages and profits. Haynes v. Druggists' Circular, 32 F. 2d 215; Johnston v. Mining Co., 148 U. S. 760; Pollitzer v. Foster, 59 F. 2d 901. The difficulty in assessing damages for acts committed so many years ago and the manifest prejudice to defendant precludes the granting of additional relief at this late date.

Motion granted with respect to paragraphs 3, 6 and 8 of the judgment; denied in all other respects. Submit amended judgment on notice.

12 6 55

SYLVESTER J. RYAN
U. S. D. J.

Opinion of the Court Below Reversing on Plaintiff's Appeal.

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 276—October Term, 1957.

(Argued March 25, 1958 Decided May 16, 1958.)

Docket No. 24042

EDWARD B. MARKS MUSIC CORPORATION,

Plaintiff-Appellant-Appellee,

—v.—

CHARLES K. HARRIS MUSIC PUBLISHING CO., INC.,

Defendant-Appellee-Appellant.

Before:

CLARK, *Chief Judge*,

LUMBARD, *Circuit Judge*, and DIMOCK, *District Judge*.

Appeals from the United States District Court for the Southern District of New York, Sylvester J. Ryan, *Judge*.

Plaintiff, Edward B. Marks Music Corporation, appeals from an order denying its motion for further relief based upon a declaratory judgment, and defendant, Charles K. Harris Music Publishing Co., Inc., appeals from a judgment declaring plaintiff the sole owner of copyrights in certain songs. Reversed in part and remanded.

JULIAN T. ABELES, New York City, *for plaintiff-appellant-appellee.*

MAXWELL OKUN, of Fishbein & Okun, New York City (Arthur L. Fishbein, of Fishbein & Okun, New York City, on the brief), *for defendant-appellee-appellant.*

CLARK, *Chief Judge:*

Plaintiff instituted this action in 1944 for a declaratory judgment that it was the sole owner of the renewed copyrights in a number of songs written by Joseph E. Howard and for an injunction restraining defendant from infringing its copyrights. Defendant asked by way of counterclaim for like relief in its favor. After numerous delays the case came to trial in 1955. The district court's judgment declared the defendant the sole owner of the renewed copyrights in 28 of the songs, and the plaintiff the sole owner of the renewed copyrights in 154 of the songs. In addition it provided appropriate injunctive relief. Thereupon plaintiff moved for an adjudication of infringement and for an accounting as further relief based on the declaratory judgment.[1] The district court denied the motion. Plaintiff appeals from this denial, and defendant appeals from that part of the judgment which declared the plaintiff to be sole owner of the renewed copyrights in the 154 songs.

We deal first with the defendant's appeal. Defendant's interest in the renewed copyrights depends on an unrecorded conveyance executed in 1916 by Howard to defendant's predecessor, Charles K. Harris, the original pub-

[1] The plaintiff also moved to alter and amend the judgment pursuant to F. R. Civ. Proc., rule 59(e), to provide that it was the sole owner of the copyrights in another group of songs in which the court found defendant had no interest and for injunctive relief with respect to these songs. This motion was granted, and defendant takes no appeal from this aspect of the case.

lisher of Howard's songs. The conveyance, which makes no mention of renewal rights, states in part that in consideration of $150 Howard conveys to Harris all his "right, title and interest by way of copyrights or otherwise * * * in and to all my musical compositions published by Chas. K. Harris of New York City." Plaintiff's claim of ownership is based on an agreement between it and Howard executed on June 6, 1933 (prior to the end of the original copyright terms), which clearly provided for the assignment of the renewal copyrights in Howard's songs. This agreement, recorded in the Copyright Office ten months after its execution, was followed by specific assignments from Howard to plaintiff of each of the litigated songs after the copyrights were renewed. Each such assignment provided that it was made pursuant and subject to the agreement of June 6, 1933, and each was duly recorded within the statutory period provided in 17 U. S. C. § 30.

In 1936, Howard executed seventeen separate assignments of the renewal rights to the songs in issue to defendant's predecessor which subsequently were recorded. But these are of no help to defendant unless the instrument executed by Howard in 1916 conveyed to Harris the renewal rights, for, prior to the 1936 assignments, plaintiff had recorded the valid agreement assigning to it the renewal rights to the songs, as we have just stated.

The cases are clear that a copyright renewal creates a separate interest distinct from the original copyright and that a general transfer by an author of the original copyright without mention of renewal rights conveys no interest in the renewal rights without proof of a contrary intention. *G. Ricordi & Co.* v. *Paramount Pictures, Inc.*, 2 Cir., 189 F. 2d 469, certiorari denied 342 U. S. 849; *Rossiter* v. *Vogel*, 2 Cir., 234 F. 2d 908. Here we have a general transfer to defendant's predecessor which makes no mention of renewal rights. But to show that Howard intended to include the renewal rights in the grant, defendant produced the deposi-

tion of Isabelle B. Monroe, who was Harris' secretary in 1916. She testified that after Howard had signed the conveyance, and in his presence, Harris stated that "all the property was ours and all the renewals became part of our catalogue." The district court rejected this deposition as determinative of Howard's intent to include the renewal rights, and we agree. It is surely tenuous at best to conclude that Howard really intended to strip himself of his separate interest in the renewals by merely saying nothing (if he heard) in response to Harris' somewhat ambiguous self-supporting statement. Actually the deposition was taken 39 years after the alleged conversation, and it is quite inconceivable that the witness remembered in detail all the relevant circumstances surrounding the event. Moreover, it is quite probable that the whole purpose of the 1916 conveyance was to extinguish Harris' liability to pay royalties to Howard pursuant to prior contracts between the principals. This is supported by one part of the conveyance which provided that Howard released Harris "from payment of royalties or otherwise by reason of any contract or understanding had between the parties concerning said musical compositions." At best, then, we have a situation where the conveyance is silent as to renewal copyrights; and the extrinsic evidence concerning intent is ambiguous. This is insufficient to support defendant's claim.

On the other hand, plaintiff's claim of ownership is based on an unambiguous agreement with Howard which clearly conveyed to it all renewal copyrights in the songs at issue and which provided that Howard would execute all necessary renewals for plaintiff's benefit. Defendant's objections to the validity of this agreement are not well taken. Most of them erroneously presume that the 1916 instrument effectively conveyed renewal rights to Charles K. Harris and that the plaintiff's alleged failure to comply with 17 U. S. C. § 30 stripped it of any rights as a bona fide pur-

chaser for value. But as we have shown, the 1916 conveyance gave defendant no interest in the renewal rights; and hence its claim of ownership must be based on the seventeen separate assignments executed by Howard in 1936. Under this analysis it is evident that plaintiff's failure to record the 1933 agreement within three months of its execution vests no rights in defendant. For defendant to prevail under §30 it had to be a subsequent purchaser without notice, and admittedly in 1936 it had notice of plaintiff's interest. Conversely, it matters little that in 1933 plaintiff might have had notice of defendant's claim, for this could have been notice only of an invalid claim. Finally, defendant says that plaintiff was not a purchaser for a valuable consideration, because the 1933 agreement provided for royalties, including an advance of $200. Although a promise to pay royalties in the future, coupled with notice of a prior claim before payment, might deprive a subsequent purchaser of the status of a bona fide purchaser under §30, *Rossiter* v. *Vogel*, *supra*, 2 Cir., 134 F. 2d 908, 911, the doctrine has no application to a prior purchaser, which is what plaintiff is here. Thus in order to upset the 1933 agreement, defendant must show the lack of any consideration, which obviously is out of the question. Plaintiff's ownership, therefore, is well supported by the record, and the district court correctly rejected defendant's claims to the songs at issue.

We come, then, to plaintiff's appeal from the denial of its motion for an adjudication of infringement and for an accounting. If plaintiff is not barred by laches this relief is proper. 28 U. S. C. §2202 specifically provides that: "Further necessary or proper relief based on a declaratory judgment or decree may be granted, after reasonable notice and hearing, against any adverse party whose rights have been determined by such judgment." We take this to mean that the further relief sought—here monetary recompense—need

not have been demanded, or even proved, in the original action for declaratory relief. The section authorizes further or new relief based on the declaratory judgment, and any additional facts which might be necessary to support such relief can be proved on the hearing provided in the section or in an ancillary proceeding if that is necessary. Cf. *Security Ins. Co. of New Haven* v. *White*, 10 Cir., 236 F. 2d 215. Here the further demand for relief is based on the declaration of plaintiff's ownership of the songs at issue and, unless otherwise barred, is proper under the statute. The real question, then, is whether the district court was correct in holding that the eleven-year delay between the institution of the suit and the trial constitutes laches which estops plaintiff from now receiving the further relief which it seeks.

Plaintiff instituted this action in 1944, some six years after it had notice of threatened infringement by defendant's predecessor. We see no basis for the application of laches concerning this six-year period, for it appears that in 1941 (some three years after notice) plaintiff commenced a suit against defendant's predecessor concerning the renewed copyright in one of Howard's songs where the question at issue was the effect of the 1916 conveyance. Although that suit was discontinued, *Edward B. Marks Music Corp.* v. *Jerry Vogel Music Co.*, D. C. S. D. N. Y., 49 F. Supp. 135, it was dropped only after defendant's predecessor withdrew her claim to the song under the conveyance, which would indicate that defendant's predecessor then believed that the 1916 conveyance did not pass renewal rights. Under the circumstances it seems clear that the plaintiff can be charged with no serious delay in instituting the suit.

Of course, as we know, failure to prosecute a suit diligently, resulting in a substantial delay which causes actual prejudice to the adverse party, can constitute laches. *D. O. Haynes & Co.* v. *Druggists' Circular*, 2 Cir., 32 F. 2d 215;

Pollitzer v. *Foster*, 6 Cir., 59 F. 2d 901. Here the delay was eleven years, and defendant contends that this should estop plaintiff from now demanding damages in addition to the awarded declaratory and injunctive relief. First, the defendant claims that plaintiff waived such additional relief by failing in its complaint to allege infringement and consequent damages. But obviously this argument is specious. If plaintiff had proved infringement on the trial it would have been entitled to damages under F. R. Civ. Proc., rule 54(c); but under the declaratory judgment statute it was not compelled to take this course. Hence defendant was not entitled to assume from the absence of a plea for damages that plaintiff would not seek them at trial. Likewise defendant was not entitled to assume that plaintiff would not seek damages after trial and entry of the declaratory judgment because plaintiff's complaint ended with the prayer "that upon application therefor, plaintiff be granted such further relief based on said declaratory judgment as may be necessary or proper"—the very procedure provided by 28 U. S. C. §2202. The course plaintiff adopted was thus not unusual.

Second, defendant contends, and the district court agreed, that the eleven-year delay prejudiced its defenses against the infringement claims. But the record shows that the defendant consented to or joined in applications for these delays. So clearly it was then unworried as to prejudice resulting from them. Moreover, its affidavits show no specific prejudice; and the court's findings of "manifest prejudice" are not supported by anything in the record. The record does show, however, commendable efforts on the part of both parties to litigate all their claims concerning ownership of Howard's songs in this proceeding. Amendments of the pleadings indicate that the claims were complex, which probably accounts to some degree for the delay.

Doubtless the parties, too, were both stimulated to renewed interest by the renaissance of old songs under the benign auspices of radio and television. Each case where laches is urged as a defense must be decided on its own facts. Under the circumstances here present it seems unfair to tax plaintiff, the rightful owner, rather than defendant, the infringing wrongdoer, with severe penalties for the delay in which they both participated.

On the defendant's appeal affirmed; on the plaintiff's appeal reversed and remanded for further proceedings in accordance with this opinion.

APPENDIX II

Judgment of Affirmance on Defendant's Appeal and Reversal on Plaintiff's Appeal.

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

At a Stated Term of the United States Court of Appeals, in and for the Second Circuit, held at the United States Courthouse in the City of New York, on the 16th day of May one thousand nine hundred and fifty-eight.

Present:

HON. CHARLES E. CLARK,
Chief Judge.

HON. J. EDWARD LUMBARD,
Circuit Judge.

HON. EDWARD J. DIMOCK,
District Judge.

EDWARD B. MARKS MUSIC CORPORATION,
Plaintiff-Appellant,

v.

CHARLES K. HARRIS PUBLISHING COMPANY, INC.,
Defendant-Appellant.

Appeal from the United States District Court for the Southern District of New York.

This cause came on to be heard on the transcript of record from the United States District Court for the

Southern District of New York, and was argued by counsel.

On consideration whereof, it is now hereby ordered, adjudged, and decreed that on the defendant's appeal the judgment of said District Court be and it hereby is affirmed; and on the plaintiff's appeal said judgment be and it hereby is reversed and action remanded for further proceedings in accordance with the opinion of this court; with costs to the plaintiff-appellant.

A. Daniel Fusaro
Clerk